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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,666	08/19/2003	Naoki Katou	4041J-000748	5749

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
FORD, JOHN K	

ART UNIT	PAPER NUMBER
3753	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/643,666	KATOU ET AL.	
	Examiner	Art Unit	
	John K. Ford	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 2/3/05.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 1,4 is/are allowed (provisionally, pending a full understanding of JP 61-32516)

6)☒ Claim(s) 2,5 is/are rejected.

7)☒ Claim(s) 3,6 is/are objected to (provisionally, pending a full understanding of JP 61-32516)

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's response of February 3, 2005 is acknowledged, with a degree of disappointment. The examiner's request for a translation has been refused. Applicant has essentially refused to provide further meaningful information about JP 61-37516 asserting, in essence, that a meaningful translation of even the smallest most relevant portion of JP 61-037516 (i.e. all of the disclosure pertaining to box 114) is "not readily available" to Denso or its overseas representatives. It is submitted that, in reality, Denso, through its overseas representatives likely, directly or indirectly, employs a small army of translators and back-translators given the thousands of applications that Denso has filed in the United States (and elsewhere) that must be translated from their corresponding foreign priority documents. The notion that a translation of nearly any foreign document world-wide is not a mere phone call or FAX away from overseas counsel given the scope of Denso's patent filings world-wide is difficult to accept at face value. Applicant offers no facts to support the conclusion that a translation is "not readily available" and in response to this action applicant is either required to produce those facts (i.e. why, given what the examiner has stated above, a translation of a Japanese reference, that is so material and important to the prosecution of this case that the examiner cannot in good conscience give it cursory consideration, into English is not readily available) or to provide the requested translation.

The examiner is well aware that applicant cannot be expected to translate every reference cited to every patent office world-wide into every native tongue, however as U.S. counsel is aware, this examiner rarely requests a translation of this assignee, and does so only where the reference cited by applicant/assignee is so pertinent and

material as to require translation for any meaningful consideration. In the past applicant/assignee has always complied with the few such requests made by this examiner and the examiner believes that it would be in Denso's best interest to do so here given patent challenges such as found in the reported case of Semiconductor Energy Laboratory Co. v. Samsung Electronics Co., 54 USPQ2d 1001 (Fed. Cir. 2000). By citing this case, the examiner is not in any way suggesting that the behavior disclosed there is related to the behavior here. What the case is cited to show is that PTO rules aside, courts have their own rules, many times more restrictive and demanding than those of the PTO, and that there are many other factors and potentially extremely costly problems that can be avoided by providing a complete translation of the most pertinent reference during a patent application prosecution. Note that the patent in question in Semiconductor Energy Laboratory Co. v. Samsung Electronics Co. was ultimately held to be invalid for conduct related to an incomplete translation of the most pertinent reference in the prosecution history.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of JP 61-37516 and either Ota (USP 6,389,824) or Kayakawa (4,730,986).

JP 61-37516, cited by applicant without translation of the most material portion, appears to disclose all of the claimed subject matter of claims 2 and 5 except, perhaps, the explicit step of selecting the bi-level mode when the cooling load is high and the face mode when the cooling load is low, as recited in the last two paragraphs of claim 2. Instead, at block 114, according to applicant's latest somewhat obscure representation of block 114 a timer of some sort is set and watched, (i.e. "this refers to whether a timer is greater than or equal to thirty seconds," response February 3, 2006, page 2, last sentence of fourth paragraph).

As taught by Ota (col. 16, line 19-col. 17, line 13) and Kayakawa (col. 6, lines 43-45), the cooling load is typically high during the initial operation and diminishes as the compartment cools off. Thus if the timer of block 114, is measuring the time from initial start-up of the system then the limitations for claim 2 are satisfied since, during the initial 30 seconds (i.e. the high cooling load time) the bi-level mode appears to be selected and after the expiration of the first 30 seconds (i.e. the low cooling load time) the face mode is selected. If not, however, it would have been obvious to have used the timer 114 of JP '516 as a proxy for cooling load determination as taught by either one of Ota (col. 16, line 19-col. 17, line 13) and Kayakawa (col. 6, lines 43-45).

The examiner strongly suggests that applicant provide a complete translation of applicant cited JP 61-37515.

The remainder of the claims appear to define patentable subject matter, however that tentative determination is subject to change once the translation is made of record, because at present the examiner's understanding of the reference is incomplete. If applicant intends to refuse this repeated request for a translation, the examiner requests US counsel to telephone the examiner as early as possible so that the examiner has time to make alternative arrangements.

Any inquiry concerning this communication should be directed to John K. Ford at telephone number 571-272-4911.